

## **REMARKS**

Claims 1-15 are pending in the application.

Claims 1-7 have been rejected.

Claims 8 – 15 had been withdrawn from consideration as being drawn to a non-elected invention.

The specification has been amended, as indicated above, to overcome objections.

No new matter has been added.

Reconsideration of the Claims is respectfully requested.

### **1. Election Requirement**

Claims 8 through 15 had been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant will cancel such claims without prejudice upon indication of allowability of the instant claims.

### **2. Objection to the Specification**

The related application information has been amended to reflect the current status of the sister case as indicated above.

The abstract was objected to in that the content does not appear to be directed to the claimed invention. Appropriate correction has been made.

### **3. Rejection under 35 U.S.C. § 102**

Claims 1, 4, 5 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,497,137 to Fujiki (“Fujiki”).

For establishing anticipation, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 at p. 2100-73 (8th ed., rev. 3, August 2005) (citations omitted).

Fujiki relates to a “chip type transformer usable as a balun transformer in an impedance converter for converting the impedance of a transmission line of a high frequency circuit having a

frequency higher than that of a UHF band . . .” (Fujiki Col. 1:8-12). Figure 2 of Fujiki illustrates a “first strip line 22 of a length  $\lambda/2$  is formed on one main surface of the third dielectric substrate 14c which is the third layer from the top layer of the laminate 12. The first strip line 22 consists of a narrower first spiral portion 24a and a thicker second spiral portion 24b.” (Fujiki Col. 4:18-22). The Office Action sets out that the “winding of Fujiki inherently reduces impedance of the on-chip inductor at an operating frequency.” But “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.” MPEP § 2112 at p. 2100-51. Fujiki is silent to the purpose of the design of the spiral portions, except for the length of the spirals. Fujiki does not set out any purpose or reason for the illustration of clipped outer corners of the spirals – such as cost reduction, resistance, ease of manufacture, et cetera.

In contrast, Applicant’s Independent Claim 1 recites “a method for manufacturing an on-chip inductor comprises: creating a dielectric layer; and creating a conductive winding on the dielectric layer, wherein the conductive winding has a substantially square geometry, wherein corners of the conductive winding *are geometrically shaped to reduce impedance of the on-chip inductor at an operating frequency.*” (emphasis added).

Accordingly, Applicant respectfully submits that each and every element as set forth in Applicant’s claimed invention is not found in Fujiki. Applicant respectfully requests that the rejection to Independent Claim 1 and Claims 4, 5 and 6 that depend therefrom be withdrawn.

#### **4. Rejection under 35 U.S.C. § 103(a)**

Claims 2, 3 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki in view of U.S. Patent No. 6,407,647 to Apel et al. (“Apel”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. MPEP § 2142, p. 2100-134 (8th ed., Rev. 3, August 2005) (citations omitted).

Claims 2, 3, and 7 depend directly or indirectly from Independent Claim 1. Because Fujiki is respectfully submitted as not substantiating a basis for anticipation of Applicant's claimed invention, Applicant also respectfully submits that the hypothetical combination of Fujiki with Apel does not teach or suggest all the claim limitations of these claims.

Also, Applicant further submits that the cited references do not convey the effect or desirability of creating geometric shaping of the corners. *See* MPEP § 2144.05 at p. 2100-134. Instead, the Office Action appears to improperly rely on a "likely to invent" criteria in the rejection.

Accordingly, Applicant respectfully submits that there has not been a *prima facie* showing that substantiates the rejection of Applicant's claimed invention. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Fujiki and Apel to achieve Applicant's claimed invention as set out in dependent claims 2, 3 and 7. Applicant respectfully requests that the rejection to these claims be withdrawn.

## **5. Conclusion**

As a result of the foregoing, the Applicant respectfully submits that Claims 1-7 in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [ksmith@texaspatents.com](mailto:ksmith@texaspatents.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126.

Respectfully submitted,

Date: April 9, 2007

/Kevin L. Smith/  
Kevin L. Smith, Reg. No. 38,620  
Attorney for Applicant

**Garlick Harrison & Markison**  
P.O. Box 160727  
Austin, Texas 78716-0727  
(972) 772-8836/office  
(972) 772-5033/facsimile